

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-3, 6, 7, 9, and 10 are currently pending. Claims 1, 7, 9, and 10 are independent.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-3, 6, 7, 9 and were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,697,948 to Rabin *et al.* (herein after, "Rabin") in view of U.S. Patent No. 5,790,935 to Payton and further in view of U.S. Patent No. 6,470,085 to Uranaka *at al.* (herein after, "Uranaka").

Applicant respectfully traverses this rejection.

In general, it would be helpful to move prosecution forward if the claimed elements were recited and addressed in the Office Action on a one-to-one basis.

The most common and helpful approach is to recite verbatim an element from the independent claim then point to a location in the cited art where the element can allegedly be found. Each dependent claim is then addressed separately.

Applicant respectfully traverses the alleged rejections for at least two reasons.

A. THE OFFICE ACTION FAILS TO ADDRESS
EACH AND EVERY ELEMENT RECITED IN
THE CLAIMS

Independent claim 1 is representative and recites, *inter alia*:

“... a selection of using an electronic mail or displaying the warning report on the screen is determined based on a predetermined report method in the output setting information.” (emphasis added).

The cited references do not disclose output setting information that includes both the threshold values AND report method information, and report address information.

The focus is in on characteristic elements of the “output setting information.”

Thus, according to claim 1, when the status code information nears the threshold value of the output setting information, the warning report is distributed by either of two methods: (1) sending the report in an electronic mail, or (2) displaying the report on a display screen. The selection of how the warning report is distributed (electronic mail or display) is determined by a predetermined report method, which is part of the output setting information that also stores, for example, threshold values of the contents usage rights information.

Thus, in an aspect of the present invention, FIG. 5 is a drawing showing a typical data configuration for output setting information. The output setting information OI contains information such as limit threshold values. The output setting information is the reference used when outputting warning data. The output setting information includes report method information, and report address information. Publ. App. pars. [0058]-[0059]; pars. [0085]-[0088].

The recited element is a positive limitation that requires output setting information to include threshold values for contents usage rights. A warning report is sent when the threshold

value is neared. The output setting information also determines the method of sending the warning report.

The Office Action **does not address** this element of the claim. The Office Action states, “With regards to the claimed limitation of “sending said warning report by a selected method, . . . when said status code information nears the threshold value . . .” (see claim 1), the Office considers this element to be **optional language**, thus it can be omitted.” (emphasis in original).

This is just a wrong interpretation of claim language. The claim term “when” is not optional language. Applicant asks for reconsideration. Applicant points to **MPEP 2173.05(g)**, which, on an unrelated topic cites with favor the use of “when” in a CAFC case:

“In *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted . . . the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." *Id.* at 1120, 72 USPQ2d at 1008.<” (emphasis added).

Moreover, the term “when” is used clearly throughout the specification. The Federal Circuit has held the claim term “when” is neither indefinite nor ambiguous and can provide a limitation on claim scope. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998) and progeny. The term “when” has the meaning as used in the specification. 158 F.3d at 1251-1252. In the present application the term “when” is described throughout the specification as, for example, “. . . the warning report data WID is outputted when status code information SC exceeds the output setting information OI.” Publ. App. Abstract.

Indeed, Uranaka, cited in the Office Action, uses “when” in claim 42. If the term rendered the limitation optional, Uranaka’s claim 42 would be reduced to, “A computer data

signal embodied in a carrier wave, wherein embodied in the computer data signal is an application package,” which would clearly be overbroad reading on just about every electronic transmission.

None of the references cited includes an output setting information that includes the elements of threshold values for contents usage rights AND, when the threshold is neared, the output setting information is consulted to determine the method of sending the warning report.

The above recited feature of claim 1 is not disclosed in any of the cited references.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 7, 9 and 10 are also believed to be patentable.

B. THE OFFICE ACTION FAILS TO ADDRESS
THE FEATURES OF EACH AND EVERY
DEPENDENT CLAIM

Claims 2, 3, 4, and 6 are dependent from claim 1 and are therefore believed patentable for at least the same reasons. Each dependent claim, however, is also deemed to define an additional aspect of the invention. Thus, individual reconsideration of the patentability of each on its own merits is respectfully requested.

In a particular example, claim 4 recites:

“wherein loading period information set with the loading timing for loading said contents usage right information, said status code information and said output setting information are set in said setting information, and said status code

information, said contents usage information and said setting information are compared based on said loading interval information.”

Applicant notes the features of claim 4 are nowhere addressed in the Office Action. In an aspect of the present invention, the monitor interval information is set with the loading intervals for the key code monitor to read the key code information and the status code information. This monitor interval information includes schedule information such as when the contents are reproduced (played), when the contents control device is started up and logged on etc. Publ. App. par. [0060].

This feature is not addressed in the Office Action.

Thus, claim 4 is believed patentable for the same reasons as claims 1 and also for this additional reason.

III. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

Claims 1-3, 6, 7, 9 and 10 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By: 

Paul A. Levy
Reg. No. 45,748
(212) 588-0800